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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

81131.7114

Application Number

10/622,876

Filed

July 18, 2003

First Named Inventor

Peter Shintani

Art Unit

2623

Examiner

Son P Huynh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71, Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/98)

☒

attorney or agent of record.

Registration number 38221

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Thomas F. Lebens

Typed or printed name

805-781-2865

Telephone number

June 2, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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DOCKET NO. 81131/7114

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.: 10/622,876

Applicant(s): Shintani et al.

Filed: July 18, 2003

Title: ELECTRONIC PROGRAM GUIDE
FEATURE FOR AV SYSTEM

Examiner: Son P. Huynh

Art Unit: 2623

Customer No.: 22242

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BRIEF IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed March 6, 2008, please enter the following brief in support of the attached Pre-Appeal Request for Review. A Notice of Appeal is also submitted herewith.

Claims 1, 3-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,585,866 (Miller et al.) in view of U.S. Patent No. 5,659,366 (Kerman).

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,585,866 (Miller et al.) in view of U.S. Patent No. 5,659,366 (Kerman), and further

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in view of U.S. Patent No. 7,032,236 (Ozkan et al.).

Claims 2, 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,585,866 (Miller et al.) in view of U.S. Patent No. 5,659,366 (Kerman), and further in view of U.S. Publication No. 2003/0149988 (Ellis) with U.S. Publication No. 2005/0204388 (Knudson et al.) incorporated into Ellis.

I. Clear Error: No *prima facie* case of obviousness has been established even if Miller and Kerman were properly combined because not all limitations are met.

To establish *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 "Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement for analyzing the subject matter "as a whole." MPEP 2141.02(II) The pending rejections do not show where the prior art teaches the following limitations even if the proposed combination of art is proper; thus, there is a clear error in the rejection.

Claim 1: Both the Miller and Kerman patents fails to teach or suggest "the EPG processor circuit outputs an on screen display (OSD) signal for displaying the history information *about a selected episode* of a program" as recited in claim 1. The EPG of the current application displays "history information for the episodes of the program that were previously broadcast," the history information includes "for example, a brief description of the plot, actors, themes, etc. of a particular program...the history might further describe the general theme of the program...and further describe the salient events which take place in that particular episode" (paragraphs 31 and 33 of the publication). The office action cites col. 14, line 41- col. 15, line 13 in attempt to support "the claimed 'history information' is interpreted as 'previously set' information/data or data or reminders previously set by the user" (Office Action mailed 03/06/2008, page 3, lines 3-4). However, Applicants respectfully disagree and assert that the REMINDER message of Miller is not history information about a selected episode of a program. Instead the REMINDER message is set to remind a user "at a predetermined time before the start of the selected program, that he or she would like to view the selected program" (Miller, col. 14, lines 48-50). Because

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Miller merely displays a REMINDER message prompting a user to view a selected episode of a program, which will be broadcast in the future, the reminder is generated before the selected episode of a program, and thus cannot be "history information," which must, by its very nature be generated after the selected episode of the program. Indeed, there would be no need, reason, use, suggestion or market demand for the system described by Miller to display a REMINDER message *about a selected episode* which has already been broadcast. And, if the Miller system was altered to provide such a reminder, after the selected episode has already been broadcast, the very purpose that Miller's system was designed to serve would be destroyed. As such, the combination of the references does not describe or suggest each element of at least claim 1, and therefore a *prima facie* case of obviousness has not been established. Therefore, the finality of the office action is in error.

In addition, claims 2-8 depend from claim 1. Therefore a *prima facie* case of obviousness has not been established with regards to claims 2-8, due to at least to their dependency on independent claim 1.

II. Clear Error: No *prima facie* case of obviousness has been established even if Miller, Kerman, and Ellis were properly combined because not all limitations are met.

As mentioned above, to establish *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 "Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement for analyzing the subject matter "as a whole." MPEP 2141.02(II) The pending rejections do not show where the prior art teaches the following limitations even if the proposed combination of art is proper; thus, there is a clear error in the rejection.

Claim 2: As mentioned above, Applicants respectfully assert that a REMINDER message is not history information about a selected episode of a program as recited in the language of claim 1. Even if reminder messages were considered history information, Applicants respectfully submit that the combination of Miller, Kerman, and Ellis (with Knudson et al. incorporated by reference into Ellis) still fails to teach all the limitations found in claim 2. The

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office action admits that Miller in view of Kerman does not disclose "displaying the history information about the selected episode of the program simultaneously with another episode of the program, wherein the selected episode of the program occurs previously to the another episode of the program" and relies on Ellis (and Knudson) to show this limitation. Applicants respectfully submit, however, that Ellis (and Knudson) also does not disclose the limitations found in claim 2. Instead Knudson discloses "a user may also view a list of all currently requested program reminders" (Knudson, paragraph 17). Knudson (incorporated into Ellis) merely discussing viewing a list of reminders and does not discuss displaying the list of reminders simultaneously with another episode of the program. In addition, there is no display of the history information about the selected episode simultaneously with another episode as, "before the scheduled broadcast time of each episode of each selected program series, the system sends a reminder message" (Knudson, paragraph 16, emphasis added). In addition, "the REMINDER message 130 queries the user as to whether to system should remind the user, at a predetermined time before the start of the selected program, that he or she would like to view the selected program" (Miller, col. 14, lines 47-50, emphasis added). The language found in both Knudson and Miller indicates the reminder messages are displayed before the broadcast of a program and not simultaneously with another episode of the program. The combination of the references does not describe or suggest each element of at least claim 2, and therefore a *prima facie* case of obviousness has not been established. Therefore, the finality of the office action is in error.

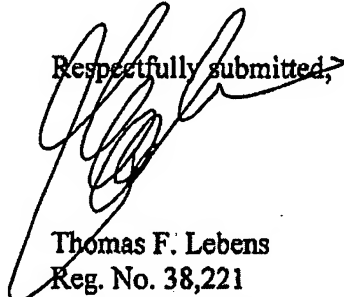
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CONCLUSION

Applicants respectfully submit that there is at least one clear error that would overcome the rejection of at least one claim; therefore, Applicants respectfully request that the final Office Action be withdrawn.

Dated: 6/2/2008

Respectfully submitted,


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